

**REMARKS**

**I. Status of Claims**

Claims 27-30 and 32-114 are pending. Claims 28-30 and 32-114 are withdrawn from consideration, by the Examiner, as directed toward non-elected subject matter. No claim amendments have been made in the Submission.

**II. Election/Restriction**

Applicant continues to traverse the restriction/election requirement for the reasons of record, including the fact that the Office has not shown that there would be a serious burden to examine the claims of Groups I-IV together, especially since the Examiner has acknowledged that two of the groups are included in the same class, 424 (Groups I and IV). See Office Action dated April 11, 2003, at page 2. This minimizes any alleged burden on the Office. In addition, Applicant submits that the burden is minimized by the fact that Group II is directed to a process of making a product, such as recited in the claims of Group IV. Thus, the search and examination of Group I should include and as such, overlap a search for the subject matter of the other groups.

Thus, in order to avoid unnecessary delay and expense to Applicant and duplicative examination by the Patent Office, the restriction requirement between Groups I, II, III, and IV should be withdrawn.

**III. Claim Rejection under 35 U.S.C. § 103**

The Office maintains the rejection of claim 27 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,643,581 to Mougin et al. ("Mougin"). Final Office

Action dated April 11, 2003, at page 3. Applicant respectfully disagrees and traverses the rejection for the reasons of record and the additional reasons set forth below.

The Office relies on Mougin for teaching a cosmetic composition comprising at least one pseudolatex based on a multiblock polycondensate, which contains a polysiloxane block and a polyurethane and/or polyurea block, wherein the polyurethane and/or polyurea block further comprises anionic or cationic groups. Office Action dated April 11, 2003, at page 5. The Office acknowledges that the reference does not teach all the claimed elements, specifically noting that it lacks a specific example of claim 27. *Id.* The Office relies on the Handbook for teaching a definition for an aerosol and that hairsprays have an average particle size of 50 micrometers. *Id.*

In view of these teachings, the Office argues that it would have been obvious to exemplify an aerosol comprising polycondensate and film-forming agents having an average particle size of 50 micrometers because of the expectation of achieving an aerosolized setting spray that uniformly and quickly delivers the setting composition to hair. *Id.* at pages 5-6.

According to the Office, the Handbook teaches the state of the art of hair care formulations and also teaches aerosols as superior to pump sprays. The Examiner also states that the Handbook teaches that aerosols conventionally deliver hairspray compositions that have a particle size of 50 micrometers. Final Office Action dated October 3, 2003, at pages 3 and 5.

The Office, however, cannot use Applicant's disclosure as a blueprint to reconstruct the claimed invention from isolated pieces of the prior art to do so contravenes the statutory mandate of § 103. *See Grain Processing Corp. v. American*

*Maze Products, Co.*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). In this case, the Office's rejection selectively picks and chooses from the references in order to create the claimed invention, while impermissibly ignoring both the art and Applicant's disclosure as a whole. *In re Wesslau*, 147 U.S.P.Q. 391, 393 (C.C.P.A. 1965).

For instance, with respect to Applicant's at least one polycondensate (A) of the hair composition, the Office asserts Mougin teaches at least one pseudolatex based on a multiblock polycondensate which contains a polysiloxane block and a polyurethane and/or polyurea block. Office Action dated April 11, 2003 at page 5. Next, with respect to Applicant's at least one film-forming polymer (B) of the composition, the Office appears to rely on a general disclosure directed to optional "conventional cosmetic additives" found in col. 11, lines 8-16 of Mougin. *See id.* In particular, these optional "conventional cosmetic additives" are chosen from

fatty substances, organic solvents, silicones, thickening agents, softeners, antifoaming agents, hydrating agents, moisturizers, treating agents (antiloss, antidandruff agents etc), anionic, nonionic or amphoteric polymers or their mixtures, antiperspirants, alkalifying agents, dyes, pigments, perfumes, preserving agents and propellant agents . . .

Col. 11, lines 8-15 (emphasis added).

Mougin's disclosure of "thickening agents" is found in a laundry list of optional "conventional cosmetic additives." This disclosure suggests the combination of these optional cosmetic additives as well as their use with the composition alone. Because "[a] reference must be considered not only for what it expressly teaches, but

also for what it fairly suggests,” (*In re Burckel*, 592 F.2d 1175, 1175, 201 U.S.P.Q. 67, 70 (C.C.P.A. 1979)), Mougin clearly provides for a vast number of possibilities without any indication of why among all those possibilities one would seek the presently claimed combination. See *In re Baird*, 16 F.3d 380, 383, 29 U.S.P.Q.2d 1550, 1552 (Fed. Cir. 1994) (citing *In re Belle*, 991 F.2d 781, 26 U.S.P.Q.2d 1529 (Fed. Cir. 1993)). In other words, Mougin does not suggest the particular use of “thickening agents” from the general disclosure of “conventional cosmetic additives.”

In addition, the Office identifies particular film-forming agents found in Mougin that are also provided in Applicant’s disclosure. Specifically, the Office identifies “film-forming agents, such as gums, crosslinked polyacrylic acids, glyceryl poly(meth)acrylate polymers, polyvinyl pyrrolidone, polyvinyl alcohols, crosslinked acrylamide polymers and copolymers, crosslinked metharyloyloxyethyltrimethylammonium chloride homopolymers and others are taught as thickeners.” Office Action dated April 11, 2003 at page 5. Mougin, however, does not suggest certain thickening agents and certainly not for the ones listed by the Office.

In response to the picking and choosing argument, the Office asserts that it is merely restating what Mougin is teaching. See Final Office Action dated October 3, 2003 at page 4. The Office, however, fails to identify in Mougin the desirability of the at least one polycondensate (A) and the at least one film-forming polymer (B). Instead, the Office chooses “thickening agents” from a laundry list of “conventional cosmetic additives” in the absence of identified parameters or preferences in the reference. In fact, Applicant’s disclosure recites the addition of “conventional cosmetic additives”

similar to those found in Mougin, as provided *supra*. Particularly, Applicant's disclosure states that

[t]he compositions in accordance with the invention can moreover contain *conventional cosmetic additives* chosen in particular from fatty substances, *thickeners*, softeners, antifoaming agents, moisturizers, antiperspirants, basifying agents, dyes, pigments, fragrances, preserving agents, surfactants, polymers other than those of the invention, volatile or non-volatile silicones, in particular anionic silicones, polyols, proteins and vitamins.

Applicant's specification at page 36, lines 20-28 (emphasis added). As such, Applicant contemplated the addition of "conventional cosmetic additives" that also includes thickeners. Therefore, unlike Mougin, Applicant's disclosure recites film-forming polymers distinct from "thickeners," whereas Mougin only recites the optional use of "thickeners." In other words, Applicant's specification clearly teaches that, if present in the claimed invention, the thickeners would be in addition to the A and B components claimed and would not itself comprise one of these compositions as the Examiner's rationale necessitates.

Alternatively, the Office asserts that "Col. 19 of Mougin exemplifies a setting spray composition packaged in a sprayer which comprises film-forming polymer (A) (pseudolatex), wherein film-forming polymer (B) is taught in the reference as an additive that increases the composition's thickness." Final Office Action dated October 3, 2003 at page 5. Here again the Office relies on the general disclosure of Mougin at col. 11, lines 8-16 to add a thickener to increase the composition's thickness.

This example in col. 19, i.e., a setting spray, lacks the expressed teaching of a thickener with the composition. In fact, as listed, the setting spray includes a pseudolatex of Example 8, perfume, dye, preserving agent, and deionized water. Col. 19, lines 5-10. Absent is a thickening agent. Moreover, absent is a thickening agent that is identified as a film-forming polymer in Applicant's disclosure. Further, all of Mougin's hair setting examples lack a thickener. See, e.g., Col. 18, line 56 – Col. 19, line 14. Thus, without a suggestion or motivation (1) to pick a "thickener" from the numerous "conventional cosmetic additives" and then (2) to choose a particular thickener identified as a film-forming polymer in Applicant's invention, Mougin's disclosure fails to establish a prima facie case of obviousness.

Furthermore, the Handbook does not cure the deficiencies in Mougin. The Office relies on the Handbook for teaching the definition of an aerosol and that "hairsprays . . . conventionally hav[e] an average particle size of 50 micrometers." Office Action dated April 11, 2003 at page 5. The reliance on the Handbook for the teachings of aerosols and hairsprays is akin to a de-facto inherency argument. As such, without further teachings demonstrating that Mougin's composition always gives the claimed composition as well as the claimed droplet size upon leaving the dispensing device, the Office's argument fails.

Under the doctrine of inherency, if an element is not expressly disclosed in a prior art reference, then the missing element must be "necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill" to anticipate the claim. *Cont'l Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991). "Inherent anticipation requires that the missing

descriptive material is 'necessarily present,' not merely probably or possible present, in the prior art." *Trintel Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 U.S.P.Q.2d 1597, 1599 (Fed. Cir. 2002) (quoting *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999)). As such, the Office's mere definition of aerosol and hairspray does not come close to establishing that the claimed polycondensate, the at least one film-forming polymer, and the device necessarily result in an aerosol having the claimed particle size. Accordingly, the combination of Mougins and the Handbook fail to generate a prima facie case of obviousness.

Therefore, absent a prima facie case of obviousness, the rejection is improper and as such, Applicant respectfully requests the withdrawal of this rejection.

#### IV. Conclusion

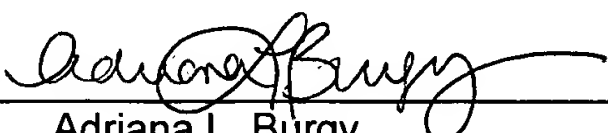
In view of the foregoing remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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